REMARKS:

Claims 1-11, 13, 15-27, 29, 31, 32

Claims 1-11, 13, 15-27, 29, 31, 32 have been rejected under 35 USC 102(e) as being anticipated by Kasajima et al. (US6751062).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In the instant case, claims 1, 15, and 31 each require a vibration absorber for reducing mechanical vibrations of the slider caused by contact of the slider with the magnetic media. In sharp contrast, Kasajima's structure is directed to damping vibrations caused by the actuator, drive arm coupled to the actuator, and suspension. *See, inter alia*, Kasajima col. 1, lines 25-31 and particularly, col. 7, line 43 to col. 8, line 9. Nowhere does Kasajima indicate that his device is capable of reducing mechanical vibrations of a slider caused by contact of the slider with a magnetic media. Rather, it is vibrations from the actuator, drive arm coupled to the actuator, and suspension that are being reduced, not vibrations originating with the slider.

Applicants further note that the vibrations sought to be reduced are parallel to the plane of the media ("in track width directions"). See Kasajima col. 7, lines 46-49. This goes along with the thrust of Kasajima's invention, to minimize vibrations from the actuator, drive arm coupled to the actuator, and suspension from being transferred to the slider.

Accordingly, Kasajima fails to anticipate each and every element of claims 1, 15 and 31. Reconsideration and allowance of claims 1, 15 and 31 is respectfully requested.

Claims 2-11 and 13 depend from claim 1, and therefore incorporate the limitations of claim 1. Accordingly, claims 2-11 and 13 are also believed to be allowable.

Claims 16-27 and 29 depend from claim 15, and therefore incorporate the limitations of claim 15. Accordingly, claims 16-27 and 29 are also believed to be allowable.

Claim 32 depends from claim 31, and therefore incorporates the limitations of claim 31. Accordingly, claim 32 is also believed to be allowable.

Additionally, regarding claims 2, 19 and 31, Applicants respectfully disagree that Kasajima discloses a vibration absorber that includes a coupling portion coupled to the slider, and a weight coupled to the coupling portion by a resiliently deformable flexure member. The rejection indicates that the claimed coupling portion is met by element 26, the weight is met by element 21, and the resiliently deformable flexure member is met by element 23. However, a closer look at Kasajima shows that the elements are not arranged as required by the claims. The elements must be arranged as required by the claim. *In re Bond, supra.*

Looking to the language of the claims, a coupling portion is coupled to the slider, and a weight is coupled to the coupling portion by a resiliently deformable flexure member. Looking to Kasajima Figs. 1-6, and using the language of the rejection for clarity without admitting that any of the claim elements are in fact shown in Kasajima, it is clear that the purported weight 21 cannot be coupled to the purported coupling portion 26 by the purported flexure member 23, because the purported coupling portion 26 is positioned between the purported flexure member 23 and purported weight 21. Thus, Kasajima really shows a purported weight 21 coupled to the purported flexure member 23 by the purported coupling portion 26. This is not what is claimed. Accordingly, the rejection is erroneous. Reconsideration and allowance of claims 2, 19 and 31 is respectfully requested.

Additionally, claims 3, 20 and 32 have been amended to require the weight being spaced from the coupling portion, the weight only being coupled to the coupling portion by the flexure member. Support for this limitation is found in 9A-12 of the present application and corresponding description in the specification. This feature is not found in Kasajima nor the other art of record.

Claims 9 and 26 have been amended to recite that the weight has a flat profile, wherein a plane of the weight along the profile is oriented at an angle with respect to an air bearing surface of the slider, the angle being greater than 0°. Support for this amendment is shown in Figs. 9B, 11B, and related description. In sharp contrast, Kasajima's element 21 lies along a plane parallel to the ABS of the slider 22, i.e., at 0°.

Claims 12, 14, 28, 30

Claims 12, 14, 28 and 30 have been rejected under 35 USC 103(a) as being unpatentable over by Kasajima in view of Giere et al. (US5940251).

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

> First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Applicants respectfully traverse the rejection as failing the *Graham* test. Specifically, the combination proposed in the rejection fails the third element of the *Graham* test.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The rejection indicates that Kasajima shows all features of claims 12, 14, 28 and 30. However, claims 12 and 14, and claims 28 and 30, depend from claims 1 and 15, respectively, and therefore incorporate the limitations of the respective parent claim. As pointed out above, Kasajima fails to show each and every element of the respective parent claim, and so the rejection based on Kasajima and Giere suffers from the same deficiencies. Therefore, the rejection fails the third element of the *Graham* test. Reconsideration and allowance of claims 12, 14, 28 and 30 is respectfully requested.

Applicants also point out that Giere, like Kasajima, is directed to damping vibration of the head suspension, not a slider as claimed. *See* Giere col. 3, lines 7-14. Giere defines the head suspension as a load beam having a mounting region, a rigid region, and a spring region, but not the slider. *See* Giere col. 3, lines 1-6. For this reason as well, the rejection based on Kasajima and Giere fails the third element of the Graham test. Reconsideration and allowance of claims 12, 14, 28 and 30 is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. HSJ920030244US1).

Respectfully submitted,

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